

Attorney Docket No.: DE 2312.02 US  
USSN: 09/932,648

PATENT  
Art Unit: 2655

### **REMARKS**

Claims 1-15 are pending in the present application.

This Amendment is in response to the Outstanding Office Action mailed May 3, 2004. In the Office Action, the Examiner objected to the drawings, rejected claims 6-15 under 35 U.S.C. §112, first paragraph, and claims 1-15 under 35 U.S.C. §102(b). Applicant has amended claims 1, 6, and 11. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### **I. DRAWINGS**

In the Office Action, the Examiner objected to drawings because descriptive labels were not provided in Figure 1. Applicant has amended Fig. 1 to include the descriptive labels. Applicant submits herewith amended Figure 1 in which the proposed changes are made. Applicant respectfully requests acceptance of this amended Figure because no substantive new matter has been added.

#### **II. SPECIFICATION**

Applicant has amended the specification to correct minor informalities. Applicant submits that the amended specification introduces no new matter. Applicant respectfully requests acceptance of the amended specification.

#### **III. REJECTION UNDER 35 U.S.C. §112**

The Examiner rejected claims 6-15 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention. Applicant has amended claims 6 and 11 accordingly. The rejection is now moot. Applicant respectfully requests the rejection be withdrawn.

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#### IV. REJECTIONS UNDER 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,104,681 issued to Yonezawa ("Yonezawa"). Applicant respectfully traverses the rejections for the following reasons.

Yonezawa discloses a decision section that decides whether an absolute value of the difference between the driving signals is above a threshold (Abstract, Col. 4 (lines 48-52), Col. 6 (lines 18-20)). The decision circuit includes a plurality of the predetermined values (decision result). A predetermined value selection circuit selects one of the predetermined values. The selected one predetermined value is supplied to a coarse actuator driving circuit (Col. 4, line 66 to Col. 5, line 3). The threshold of the decision circuit is set to extract only the sudden change of a friction stop eliminating effect of the noise (Col. 5, lines 14-16). Unlike the present invention, the predetermined value in Yonezawa is not generated from an amplified tracking error signal.

Yonezawa does not disclose, suggest, or render obvious a predetermined value being generated from an amplified tracking error signal.

To support a 102 rejection, the Examiner must show that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bro. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987), (MPEP §2131). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (MPEP §2131). Here, the Examiner has not pointed out the specific language in Yonezawa that teaches a predetermined value being generated from an amplified tracking error signal.

Yonezawa, taken alone or in any combination, does not disclose, suggest, or render obvious a predetermined value being generated from an amplified

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tracking error signal. Therefore, Applicant respectfully requests that rejection be withdrawn.

Therefore, Applicant believes that independent claims 1, 6, 11 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. §102(b) be withdrawn.

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**CONCLUSION**


In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 04-1175.

Respectfully submitted,

DISCOVISION ASSOCIATES

Dated: July 2, 2004

  
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